

REMARKS

I. Status of the Application

Claims 1-6 and 34 are at issue in this application with claims 7-33 withdrawn. By way of this response, claim 34 is amended. Applicants are filing the present RCE in order to make additional claim amendments and submit additional arguments, and to submit additional evidence in the form of a Declaration under 37 C.F.R. §1.132.

II. Claim Rejections under 35 U.S.C. §112

Applicants respectfully traverse the rejection of claims 1 and 34 under 35 U.S.C. §112 as failing to comply with the written description requirement. Reconsideration and withdrawal of the rejection of claims 1 and 34 is respectfully requested in view of the amendment to claim 34 and the following remarks.

A. Claim 1 finds clear support in the written description.

Claim 1 has been previously amended to clarify that payment history data obtained from a member's accounting system is associated with at least one of a plurality customers and is indicative of a quality of credit associated with this (at least one) customer. The Office Action asserts that "there is no teaching of any type of quality of specification," and requires that the applicants cancel the amendment. The applicants disagree. The description "should provide clear support *or* antecedent basis for all terms used in the claims." *MPEP* 608.1(g) (emphasis added). Although the specification does not apply the word "quality" to payment history data, the specification discusses, in great detail, numerous qualitative aspects of customers' payment history, and therefore discloses the use of a payment history data that is indicative of a quality of credit. As an initial matter, the background section of the disclosure explains that lenders obtain payment history information in an effort to identify creditworthy deals with customers (*see, e.g., pages 1-2*). Thus, the applicants clearly indicate that payment history information may reflect whether a certain customer has "good" credit and is therefore creditworthy, or "bad" credit and therefore present a risk. In other words, the specification discloses payment history data indicative of a quality of credit associated with at least one customer on pages 1-2.

The specification also discusses an example structure of a payment history data file 122 that may include a delinquency status for a lease, the number of times the customer has been late in paying, etc. (*see, e.g., pages 15-16*). In addition to these generally “bad” indicators, the payment history data file may include original amount, payment amount, loan status, and other indicators which evaluation generator 54 of the apparatus 10 may ultimately use to generate, in part, “a scoring of the borrower’s payment ability,” (*page 22, lines 6-7*), i.e., a credit quality metric. Because the evaluation generator 54 generates this and other metrics based on payment history data (*see, e.g., Fig. 10*), the payment history data is indicative of a quality of credit associated with a customer. Thus, the amendments introduced in the Response filed August 25, 2008, are fully supported.

Further, because the application discusses specific examples of using payment history data and, in particular, of using information in payment history data that is indicative of a quality of credit associated with a customer, the phrase “a quality of credit” does not render any of the claims indefinite. “The definiteness of the language must be analyzed, not in a vacuum, but always in light of the teachings of the disclosure as it would be interpreted by one of ordinary skill in the art. Applicant's claims, interpreted in light of the disclosure, must reasonably apprise a person of ordinary skill in the art of the invention.” *MPEP* 2106(V)(a). Clearly, a person of ordinary skill in the art would be able to reasonably construe the claims at least in light of the passages and drawings discussed above. Moreover, because the claim does not recite a quality of, for example, credit *information* or, credit *data*, the scope cannot be reasonably extended to accurate or inaccurate information, as the Office Action suggests on page 4. Therefore, the grammatical structure of the claim provides further guidance to one of ordinary skill in the art regarding the scope of the claims, and the pending claims are not indefinite for this additional reason.

B. Amended claim 34 finds literal support in the written description.

Although the currently pending claim 34 is fully supported by the written description, the applicants amend claim 34 in the interest of advancing this case to allowance.

In particular, claim 34 now recites, in part, “obtaining customer credit and business information data from an accounting system of a commercial lending company,” and specifies that “the customer credit and business information is associated with at least a first customer and includes at least one of lease obligation, loan obligation, and payment history.”

The terms “customer credit and business information data,” “commercial lending company,” “lease obligation, loan obligation, and payment history,” and “accounting system” find literal support on page 4, lines 8-19 and page 14, lines 17-21, for example. The applicants respectfully submit that this amendment cures the alleged deficiency of claim 34.

III. Claim Rejections under 35 U.S.C. §103

Applicants respectfully traverse the rejections of claims 1-6 and 34 as unpatentable over Schrader (US 5,903,881) in view of “Automated credit reporting: an idea whose time has come” by Pamela W. Peters (“Peters”) alone or further in combination with US Patent No. 6,119,103 to Basch et al. (“Basch”). Reconsideration and withdrawal of these rejections is respectfully requested in view of a declaration pursuant to 37 C.F.R. §1.132 (“the rule 132 declaration”) signed a named co-inventor, William Phelan, which is submitted herewith. The applicants also include several relevant remarks previously presented in the Pre-Appeal Brief Request for Interview filed April 10, 2009.

A. The cited references fail to disclose every element of claim 1 or 34.

The applicants have previously pointed out that Schrader generally relates to personal banking on a personal computer, and accordingly proposes a software product that helps an individual user to manage his or her banking account by presenting transaction instructions, cleared transactions, and uncleared transactions in three separate windows on a computer display. See *Amendment filed August 25, 2008, pp. 11-12*. Schrader thus attempts to improve user experience in making and viewing payments corresponding to his or her *personal* account. The Office Action agrees that Schrader does not teach a quality of credit, and that Schrader does not teach providing payment history report to a requestor. *Page 5*. However, the Office Action argues that Schrader teaches obtaining payment history data associated with at least one of a plurality of customers. *Id at 4*. The applicants have previously suggested that the Examiner probably interprets the financial institution (i.e., the bank) of Schrader as a member’s accounting system and the user operating the online banking software product as a customer of claims 1-6 and 34. *Amendment filed August 25, 2008, p. 12*. The final Office Action does not indicate otherwise.

Meanwhile, Peters discusses a possible standard “for the submission and reporting of information on commercial accounts” (*page 4*), to be used by trade creditors and bankers

(page 2). It is not clear how the personal banking software of Schrader could benefit from Peters at all, nor does the Office Action provide guidance in this regard beyond asserting that “it is within the capabilities of one of ordinary skill in the art to have credit information of more quality when assessing payment history data.” *Page 5*. It remains unclear, for example, *what* information a bank may provide to a user of Schrader to improve its quality, nor could any data discussed in Peters be useful to the user. In particular, the data of Peters relates to a credit applicant for use by a potential lender. *Page 1*. Clearly, the user of Schrader would not lend money to herself, and the system of Schrader therefore cannot benefit from Peters in any way, particularly if combined with Peters as proposed in the Office Action. Thus, the proposed combination of Schrader and Peters cannot include obtaining payment history data from a member’s accounting system, wherein the payment history data is associated with at least one of a plurality of customers and is indicative of a quality of credit associated with the at least one of a plurality of customers, as recited in claim 1.

Further, as the applicants have previously argued, providing any type of data associated with the user to a requestor, as recited in claim 1, would be antithetical to the purpose of the *personal* finance product of Schrader because the user described in Schrader clearly expects privacy with respect to his personal information. *Amendment filed August 25, 2008, p. 13*. In other words, irrespective of whether any reference at all teaches providing information to a requestor upon receiving a request, such teaching cannot be combined with Schrader because this act would impermissibly render Schrader unsatisfactory for its intended purpose. *See* MPEP 2143.01 (V). In this regard, the Office Action merely asserts that “applying the known technique of Peters would have yielded predictable results and resulted in an improved system,” and that this improved system “would allow more functionality to Schrader.” *Page 6*. Thus, the Office Action also failed to establish a *prima facie* case of obviousness with respect to this element.

Generally with respect to combining Schrader with Peters, the applicants submit that these references in combination cannot produce predictable results (much less if combined in the manner proposed in the Office Action), and therefore fail to render the pending claims obvious under 35 U.S.C. §103(a). *See* MPEP 2143 (III). More specifically, Schrader describes a bookkeeping program that allows a bank customer to track his or her own account balance and to make online payment. The Schrader product does not perform any form of

credit evaluation. Moreover, this product neither performs nor requires any type of credit assessment vis-à-vis the account holder. Instead, the Schrader product operates with an existing bank account, and the corresponding financial institution is holding the customer's money, not extending credit to the customer. Assuming, for the purposes of this discussion, that Peters discloses payment history data indicative of a quality of credit, Peters only contemplates using such data in reports to prospective lenders. Yet Schrader neither teaches nor suggests prospective lenders or third-party entities of any kind. As a result, using the data described Peters in a Schrader system does not yield a predictable result: would a user of the personal banking application receive credit information related to another user? Would the user provide his credit information to another user upon request? Would a lender request credit information directly from the user? Because the probable result of applying Peters to Schrader is unclear, the combination of Peters and Schrader is invalid for the purposes of rendering claims 1 or 34 obvious.

B. The rule 132 declaration provides convincing evidence that the method recited in claim 1 was not obvious to one of ordinary skill in the art at the time of invention.

Even assuming that a *prima facie* case of obviousness could be shown, 37 §C.F.R. 1.132 permits applicants to submit objective evidence of secondary considerations in the form of affidavits or declarations to traverse an obviousness rejection. Accordingly, the Rule 132 declaration provides a strong indication that at the time of invention, one of ordinary skill in the art would not find it obvious to automatically obtain and exchange credit information in the manner recited in claim 1. In particular, the Rule 132 declaration demonstrates that a system that implements claim 1, the credit exchange system of PayNet, Inc. ("the PayNet system"), has enjoyed significant commercial success as evidenced by the number of clients and the volume of financial transactions which the PayNet system supports (paragraphs 7-8). The Rule 132 declaration attributes at least a large part of the commercial success to the method recited in claim 1.

It is noted that membership of eight of the top ten U.S. commercial lenders in the PayNet system provides a particularly strong indication that the PayNet system in general, and the method of claim 1 implemented by the PayNet system in particular, provide a

solution to an important technical problem. The Rule 132 declaration further demonstrates that at the time of invention, the PayNet system addressed a long-standing, unresolved need for automatically exchanging credit information (paragraph 5). In this regard, it is noted that the signatory of the Rule 132 declaration was at the time of invention, and is today, highly qualified to assess the state of the art to which the method of claim 1 pertains (paragraphs 1 and 2). Thus, it is respectfully submitted that the Rule 132 declaration provides convincing evidence of non-obviousness at least with respect to claim 1.

IV. Conclusion

For the foregoing reasons, the applicants respectfully request reconsideration and allowance of claims 1-6 and 34. If there are matters that can be discussed by telephone to further the prosecution of this application, the applicants respectfully request that the examiner call their attorney at the number listed below.

Although the applicants believe that no additional fees or petitions are due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 13-2855 of Marshall, Gerstein & Borun, LLP under Order No. 29804/36569A.

September 10, 2009

Respectfully submitted,

By 

David C. Read, Reg. No. 39,811
MARSHALL, GERSTEIN & BORUN LLP
233 S. Wacker Drive, Suite 6300
Sears Tower
Chicago, Illinois 60606-6357
(312) 474-6300
Attorney for Applicants